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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/625,915 | 07/23/2003 | Andrew Wells Phelps | UVD 0280 IA/UD 268 | 3052 |

7590 09/30/2005

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| EXAMINER |
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ZHENG, LOIS L

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| ART UNIT | PAPER NUMBER |
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1742

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/625,915

Applicant(s)

PHELPS ET AL.

Examiner

Lois Zheng

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-166 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-166 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-49 and 163, drawn to a corrosion-inhibiting conversion coating, classified in class 252, subclass 387.
 - II. Claims 50-82 and 164, drawn to a process of making a corrosion-inhibiting sealing bath, classified in class 148, subclass 243.
 - III. Claims 83-131 and 165, drawn to a process of applying a corrosion-inhibiting sealing bath, classified in class 148, subclass 256.
 - IV. Claims 132-162 and 166, drawn to a corrosion-inhibiting conversion coating, classified in class 106, subclass 14.12.
2. Inventions II and I/IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process of invention II can be used to make other and materially different product such as a corrosion-inhibiting seal that is not colored or does not contain a color-fastness improver as recited in invention group I or does not contain preparative agent as recited in invention group IV.
3. Inventions I/IV and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially

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different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process of invention III can be practiced with a materially different product such as a corrosion-inhibiting seal that is not colored or does not contain a color-fastness improver as recited in invention group I or does not contain preparative agent as recited in invention group IV.

4. Inventions II and III are related as process of making and process of using the product. The use as claimed cannot be practiced with a materially different product. Since the product is not allowable, restriction is proper between said method of making and method of using. The product claim will be examined along with the elected invention (MPEP § 806.05(i)).

5. Inventions I and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the coating composition of invention I does not require a solvent as recited in the invention group II. The subcombination has separate utility such as corrosion-inhibiting seal.

6. Claims 11-31 are generic to a plurality of disclosed patentably distinct species comprising inorganic valence stabilizer and organic valence stabilizer. Applicant is

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required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

7. Claims 38-42 are generic to a plurality of disclosed patentably distinct species comprising cationic solubility control agent and anionic solubility control agent.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

8. Claims 45-48 are generic to a plurality of disclosed patentably distinct species comprising active UV blocker, passive UV blocker and brightener. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

9. Claims 50, 52, 58-60 and 164 are generic to a plurality of disclosed patentably distinct species comprising cerium source, praseodymium source and terbium source. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

10. Claims 63-67 and 76-77 are generic to a plurality of disclosed patentably distinct species comprising fluorides, chlorides, bromides, acidic species and hydroxides. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

11. Claims 69-73 are generic to a plurality of disclosed patentably distinct species comprising cationic solubility control agent and anionic solubility control agent. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

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12. Claims 83, 89, 97-99 and 165 are generic to a plurality of disclosed patentably distinct species comprising cerium source, praseodymium source and terbium source. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

13. Claims 107-111 and 125-126 are generic to a plurality of disclosed patentably distinct species comprising fluorides, chlorides, bromides, acidic species and hydroxides. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

14. Claims 118-122 are generic to a plurality of disclosed patentably distinct species comprising cationic solubility control agent and anionic solubility control agent. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

15. Claims 132-133, 138-140 and 166 are generic to a plurality of disclosed patentably distinct species comprising cerium source, praseodymium source and terbium source. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

16. Claims 142-146 and 156-157 are generic to a plurality of disclosed patentably distinct species comprising fluorides, chlorides, bromides, acidic species and hydroxides. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

17. Claims 149-153 are generic to a plurality of disclosed patentably distinct species comprising cationic solubility control agent and anionic solubility control agent.

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Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

18. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

19. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

20. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFT 1.143).

21. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lois Zheng whose telephone number is (571) 272-1248. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LLZ

ROY KING 
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700